

Application No.: 09/846,703

Docket No.: 09637/000L305-USO

REMARKSPending Claims

It is alleged in the Office Action that "newly submitted and amended claims 1-3, 21, 22, 34, 35, 37, and 38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the first and second drive branching links are directed towards non-elected species A2, A5, A6, and A7 and (not to elected species A1; paragraph 140)." The Office Action continues on to state that "[a]ccordingly, claims 1-3, 21, 22, 34, 37, and 38 are withdrawn from consideration as being directed to a non-elected invention."

Applicants firmly believe the above action is improper for several reasons (each of which is sufficient by itself) and respectfully request that claims 1-3, 21, 22, 34, 35, 37, and 38 be reinstated for consideration.

1) First, newly submitted and amended claims are directed to elected species A1. Note that in the election/restriction requirement dated September 27, 2002, species A1 is directed to Figs 1-4. Figs. 1-4 and the accompanying drawings disclose first and second drive branching links. For example, in describing Fig. 2, the specification on page 13 describes "a pair of drive branching links 27 rotatably connects each first pin 34 to lower support point pin 25." Fig. 2 itself clearly shows a pair of drive branching links 27. For at least this reason, withdrawing claims 1-3, 21, 22, 24, 35, 37, and 38 from consideration is improper because these claims all read on elected species A1. Applicants request that the finality of the Office Action be withdrawn and the claims be considered.

2) Second, claim 1 was amended from "at least one drive branching link in said means for guiding said slide drive device" to "first and second drive branching links separately coupled to said guiding means."¹ The "drive branching link" feature was amended to more clearly read on Figs. 1-4. It is clear from Fig. 2 that a pair of drive branching links 27 is shown to be separately

¹ Note that linear guiding mechanism 20 includes a base 22 and a slider 23. See page 12, lines 22 and 23. Therefore, it is clearer to state that the drive branching links are separately coupled to the guiding means rather than being "in" the guiding means.

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coupled through a pin (pin 25) to move separately from each other. Page 14, lines 17 to 18 in reference to Fig 2, states that "[e]ach branching link 27 converts the vertical reciprocation of slider 23 into oscillation of each upper toggle link 30." Amended claim 1 reads on elected Species A1. Applicants respectfully request for at least the foregoing reason that the finality of the Office Action be withdrawn and claims 1-3, 21, 22, 24, 35, 37, and 38 be reinstituted for consideration.

3) The Office Action asserts that the invention as set forth in amended claim 1 is "directed to an invention that is independent or distinct from the invention originally claimed." However, claim 1 was amended from in pertinent part

at least one drive branching link in said means for guiding said slide drive device;
 at least one of a first and a second upper toggle means;
 said at least one upper toggle means for driving said slide in a cycle;
 said at least one drive branching link transferring said guiding displacement to said one upper toggle means; and
 said one upper toggle means being effective to transfer said guiding displacement to said slide and drive said slide through said cycle.

to

first and second drive branching links separately coupled to said guiding means;
 first and second toggle means coupled respectively to the first and second drive branching links, and said first and second toggle means coupled separately to the slide;
 wherein the first and second drive branching links respectively converts the linearly guided displacement motion to a toggling motion of the first and second toggle means, and the first and second toggle means transfer the toggling motion to a linear cyclic motion of the slide.

If original claim 1 and amended claim 1 are independent or distinct from each other as deemed in the Office Action, then this means that either (a) one has no relationship with the other or (b) one is novel and unobvious over the other.² As it stands with original claim 1 and amended claim 1 being independent or distinct from each other, they would logically not be subject to a terminal disclaimer if they are placed in separate applications. Because original claim 1 and amended claim 1 have the corresponding elements and both read on Figs. 1-4, it is difficult to

² The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER. MPEP 802.01

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imagine why they would not be subject to a terminal disclaimer but the Office Action is espousing that they are not so subject to. It appears to Applicants that such a conclusion is inconsistent and illogical. For at least the above reason, Applicants submit that withdrawal of claims 1 is improper. Withdrawal of other claims 2, 3, 21, 22, 24, 35, 37, and 38 having similar limitations as claim 1 is also improper. For at least the foregoing reason, Applicants respectfully request that the finality of the Office Action be withdrawn and the claims be considered.

On page 6 of the Office Action, it is stated that "first and second drive branching links (presumably 27 and 51 as there is no antecedent basis for the first and second designation) are directed to non-elected species as confirmed by applicants' specification (paragraph 140).

Applicants respectfully point out that just because Paragraph [0140] states that "[i]t is understood that where linear guide mechanism 20 provides reciprocating motion along an inclined linear line, the second, fifth, sixth, or seventh embodiments employ drive branching links 27, 51 to simplify the device and maintain precision," this in no way excludes the usage of drive branching links in other embodiments. As previously described, Fig. 2, which illustrates the first embodiment, shows a pair of drive branching links 27. Therefore, claim 1 and other claims with first and second drive branching links read on Fig. 2 and on the first embodiment. Clearly, Paragraph [0140] having no exclusivity language provides no reason to withdraw the claims from consideration.

It is further pointed out that claims that read on more than one species are generic claims that should be considered on their merits, not withdrawn. Even if the amended claims and new claims read on other species (e.g. species with drive branching links 51) as well as on the elected species (e.g. A1), that is no reason to withdraw the claims from consideration. Applicants respectfully point out that this issue was vigorously contested and petitioned in another case and it was ruled completely in favor of Applicants that any generic claim that read on the elected species must be considered together with the elected species claims.

In summary, Applicants submit that the finality of the Office Action is premature. It is respectfully requested that the finality of the Office Action be withdrawn and claims 1-3, 21, 22, 24,

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35, 37, and 38 be fully considered on their merits in view of the arguments made in the previous Office Action response filed January 5, 2005. Applicants earnestly request the cooperation of the Examiner to further the prosecution of this case. Applicants plans to petition the withdrawal of the claims if they are not fully considered in the next office action.

Claim Rejections – 35 USC §102

Claims 17 has been rejected under 35 USC §102(b) as being anticipated by Thomas. Applicants respectfully submit that claim 17 is not anticipated by Thomas for at least the following reason.

Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). The present invention as set forth in claim 17 is directed to “a slide drive device for a press machine having a slide.” On the other hand, Thomas describes a stroke adjustment device for pickling machines. Thomas states in column 1, lines 9 to 31:

A pickling machine is described in DE 3,716,802, which serves for injecting pickling brine into the goods to be pickled by means of a number of needles. The needles are arranged on a needle carrier, which is arranged so that it moves vertically over a conveyor for the pickling goods. After the pickling goods have been introduced onto the conveyor, the needle carrier is lowered so that the needles can penetrate into the pickling goods. A lower holder that can be moved relative to the needle carrier is first lowered together with the needle carrier and then arrives in position on the upper side of the pickling goods, so that it falls short relative to the needle carrier. The relative motion between lower holder and needle carrier serves for controlling valves for the input of brine, so that the brine is released from the needles only if they have penetrated into the meat. In the subsequent upward motion of the needle carrier, the lower holder serves for the purpose of removing the pickling goods from the needles. If the needles are retracted from the pickling goods, and the lower holder has been lifted off again from the pickling goods, the conveyor is placed in operation for a brief time, so that the now pickled goods can be transported off and new pickling goods are introduced. In this way, a new pickling cycle can begin.

Thomas' invention has a mechanically driven needle carrier 12 (allegedly equivalent to a slide of claim 17) containing needles for driving needles into pickling goods to release brines into the goods. The slide for a press machine clearly is not a needle carrier for carrying needles and would be inoperable if a needle is used. Stated in another way, a stroke adjusting device for

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